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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,825	04/05/2004	Shigenobu Kushihashi	1131-0507PUS1	5012

2292 7590 12/23/2004

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EXAMINER
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OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/816,825

Applicant(s)

KUSHIHASHI ET AL.

Examiner

Mark A Osele

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04052004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1734

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II in the reply filed on November 29, 2004 is acknowledged. The traversal is on the ground(s) that improper guidelines for distinctness were used. This is not found persuasive because although the application is a national phase application based on a PCT application it was not filed under rule 371 so U.S. restriction guidelines are appropriate. Under U.S. restriction practice, only one way distinctness is required between an article and process of its use. In addition, the different classification of the two inventions is evidence of a searching burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication WO00/13997 (Suzuki) in view of Brookman et al. Because PCT Publication WO00/13997 is printed in Japanese, teachings therefrom will be referenced to EP 1177997 which is an English language equivalent. Suzuki

Art Unit: 1734

shows a feeding device of a splicing tape for an automatic splicing device of webs, the automatic splicing device splicing a first web being fed from an active roll along a main delivery path to wrap a filling material into a rod shape and a second web drawn from a standby roll in a stand-by state along a sub-delivery path with a splicing tape fed from said feeding device between the first and second webs, and cutting the first web upstream from a splicing portion of the first web and the second web, the main delivery path and the sub-delivery path each having a feeding position for receiving supply of said splicing tape; said feeding device comprising: a feeding reel, 58, wound with a web-like base material, D, wherein the base material has a large number of splicing tapes, A, attached thereto at prescribed intervals in a longitudinal direction thereof; a take-up reel, 32, capable of taking up the base material fed from said feeding reel; a feeding path extending between said feeding reel and said take-up reel to guide the feeding of the base material, said feeding path including a peeling member, 74, located above said feeding position, said peeling member having a tip directed to said feeding position, thus peeling one splicing tape off the base material and making said splicing tape hang from the base material toward said feeding position when the base material passes said tip of said peeling member; and driving means for feeding every given length of the base material from said feeding reel by controlling rotation of said take-up reel. Suzuki fails to show the peeling tip to be a sharp tip from which the splicing tapes hang.

Brookman et al. shows a device for separating double sided adhesive tapes from a backing web wherein the web travels over a sharp tip, 40, to

Art Unit: 1734

separate the tape from the web (See Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tip of Suzuki sharp as shown by Brookman et al. because a sharp tip provides a greater peeling force than a right angle.

***Allowable Subject Matter***

4. Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art suggests a splicing tape with a longitudinal rigidity greater than the width rigidity. Kearby et al. shows a splicing tape perforated to increase its elongation. Held also discusses the elongation of a splicing tape but neither reference suggests the rigidity greater in one direction than another.

Regarding the limitations of claim 7, Bottcher et al. teaches that when splicing cigarette paper it is beneficial to operate both the expiring web and the fresh web at the same speed and creating a flying splice (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to operate a cigarette paper splicing operation at production speeds

Art Unit: 1734

because Bottcher et al. teaches that this prevents breaking of cigarette paper (column 2, line 54 to column 3, line 18).

Regarding the limitations of claim 8, Pettis, Jr. et al. teaches the use of an air nozzle, 46, directed at the peeling tip, 42, of a label applicator to ensure that the label, 20, is fully peeled from the backing web (Abstract; Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the air nozzle of Pettis, Jr. et al. to a splicing apparatus to ensure that the adhesive tabs are fully separated from the backing web as shown by Pettis, Jr. et al.

Regarding the limitations of claim 9, Suzuki shows the feeding device to have an operating position located right above the feeding position (See Fig. 5) and a retreating position located away from the peeling position (See Fig. 2).

### ***Conclusion***

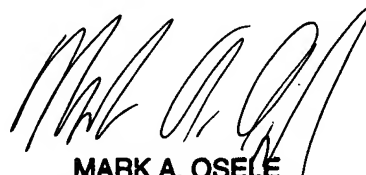
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Benson et al. shows splicing of webs both running at production speeds. Saitoh et al., Klingebiel, Meinke, and Krywicznanin et al. each show double sided adhesive splicing tabs peeled from a backing web.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

Art Unit: 1734

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MARK A. OSELE**  
**PRIMARY EXAMINER**

December 12, 2004